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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/007,268 01/14/98 LOWE, J PC7981C

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HM12/0617

EXAMINER

DELACROIX MUIRHEI, C

ART UNIT

PAPER NUMBER

1654

DATE MAILED:

06/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/007,268

Inventor(s)

LOWE

Examiner

Ex. DELACROIX

Group Art Unit

1654

☒ Responsive to communication(s) filed on 4/16/99

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-32 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-32 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

DETAILED ACTION

The following is responsive to Applicant's election received April 16, 1999.

Said election has been considered and found to be incomplete for reasons being that the previous restriction requirement did not clearly set forth the grounds for restriction/election. Accordingly, the following supplemental restriction is being submitted.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1- 26, 28, 30 and claims 27, 29, 31, drawn to compounds and methods of use, wherein "Q" is II, III, IV, V, VI, classified in class 540, subclass 546+.
 - II. Claims 1-26, 28, 30 and claims 27, 29, 31 drawn to compounds and methods of use, wherein "Q" is VII and which may be a 4-9 membered ring, classified in class 548, subclass 1+.
 - III. Claims 1-26, 28, 30 and claims 27, 29, 31 drawn to compounds and methods of use, wherein "Q" is VIII, classified in class 546, subclass 1+.
 - IV. Claim 32, drawn to intermediates classified in class 546 , subclass 223+.
2. The inventions are distinct, each from the other because of the following reasons: Groups I, II, III and IV are distinct because the disclosed compounds are structurally and chemically distinct and one compound would not suggest substitution with the other.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. This application contains claims directed to the following patentably distinct species of the claimed invention: in Group I, species II, III, IV, V and VI; in Group II, species wherein the ring may be a 4-9 membered ring as determined by "X", which is (CH₂)_q, wherein q is from 1-6; Group III, wherein x , y and z

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are as defined. Applicant is required to elect a single species within a group, for example, if Group II is elected then Applicant may further elect the species where "X" in the ring structure is (CH₂)₃ or if Group I is elected then a further election of species where "Q" is IV is required, or, if Group III is elected, then Applicant may further elect a species where "x"=1, "y"=0 and "z"=three. Please note that these are just examples.

With respect to method claims 27, 29, 31, Applicant must elect a single method of use which will be searched along with the elected compound. For example, if Group II is elected with a further election of species of "X" being (CH₂)₃, then Applicant must elect a single method of use for said elected compound, for example, "A method of treating or preventing inflammatory diseases (see claim 27, lines 17-18).

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cybille Delacroix-Muirheid whose telephone number is (703) 306-3227. The examiner can normally be reached on Tue-Fri from 8:30 to 6:00. The examiner can also be reached on alternate Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang, can be reached on (703) 308-0254. The fax phone number for this Group is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

CDM



June 15, 1999



Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600